

REMARKS

Claims 1-27 are pending in this application. Claims 1-6, 11, 12, 14, 15 and 18-24 are currently under consideration. Claims 7-10, 13, 16, 17 and 25-27 are withdrawn from consideration as being directed to a non-elected invention. Claims 1 and 2 are newly amended herein. Applicants reserve the right to pursue any cancelled subject matter in one or more continuing or divisional applications.

Support for the amendments to claim 1 is found, for example, in original claim 1, and elsewhere throughout the specification. Claim 1 is amended to more clearly claim that it is the activity of the entity of the entity-ligand-support complex separated in step (iii) which is being assayed.

Claim 2 is amended to move the phrase “cells, bacteria, viruses, yeast” after the term “isoform.” The claim was amended to more clearly claim the invention.

No new matter is believed to be introduced by this amendment and entry is respectfully requested.

A. RESTRICTION

Applicants acknowledge the finality of the restriction. Applicants elected Group I, claims 1-24, and elected peptides as the species of ligand, polymethacrylate as the species of support, conditioned cell medium as the species of mixture/composition, protein as the species of entity and cell proliferation as the species of activity in the reply filed May 10, 2006. Claims 7-10, 13, 16 and 17 are withdrawn from consideration as being directed to a non-elected invention.

As the Office is aware, should no prior art be found that anticipates or renders obvious the elected species, the search of the Markush-type claims will be extended to include the other species.

B. REJECTIONS

1. Rejection Under 35 U.S.C. § 102(b) over Todaro

Claims 1-6, 11, 12, 14, 15, 18 and 20 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Todaro (U.S. Patent No. 4,816,561). The rejection is respectfully traversed. Claims 1 and 2 are newly amended herein.

The Office argues, *inter alia*, Todaro allegedly teaches a method of screening aqueous solutions for polypeptides by providing antibodies or antigens on the supports with cells expressing TGF polypeptide, separating the cells with a fluorescence activated cell sorter, assaying for cell growth, detecting cell growth, and selecting the molecule with activity. The Office also argues that Todaro allegedly teaches, *inter alia*, contacting aqueous heterogeneous solutions comprising TGF and peptides of TGF with HPLC columns, separation, assaying for cell growth, detecting cell growth and selecting TGF or TGF peptides.

As the Office is aware, a reference must teach each and every element as set forth in the claim in order to anticipate. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Todaro does not anticipate claims 1-6, 11, 12, 14, 15, 18 and 20 for at least the following reasons. In the instant case, Todaro does not disclose separating at least one entity-ligand-support complex from the **unbound** entities, and, assaying the activity of the entity of the at least one entity-ligand-support complex separated in step (iii) as is claimed in newly amended claim 1. Thus, contrary to the Office, columns 5 and 10-16, Examples I-XV and Tables I-IX, do not teach the invention as **claimed**. In addition,

Todaro fails to show the identical invention in as complete detail as is claimed in currently amended claim 1.

Because Todaro fails to teach each and every element of the claim and fails to teach the invention as **claimed**, Todaro cannot anticipate claim 1, or, claims 2-6, 11, 12, 14, 15, 18 and 20, dependent therefrom. If the Office maintains this rejection, the Office is respectfully requested to provide a detailed explanation (i.e., cite to specific lines of Todaro) of where Todaro teaches the invention of claim 1 as newly amended.

In view of the deficiencies of Todaro, the rejection of claims 1-6, 11, 12, 14, 15, 18 and 20 under 35 U.S.C. § 102(b) is legally improper. Reconsideration and withdrawal of the rejection is respectfully requested.

2. Rejection Under 35 U.S.C. § 102(b) over Lam

Claims 1-6, 11, 12, 14, 15 and 18 -24 are rejected under 35 U.S.C. § 102(b) as purportedly being anticipated by Lam et al. (U.S. Patent No. 5,510,240). The rejection is respectfully traversed. Claims 1 and 2 are newly amended herein.

The Office argues Lam allegedly teaches methods of screening peptide libraries via a library of bio-oligomers (i.e., peptides) attached to solid phase supports (i.e., ligand-support), introducing an acceptor molecule or substrate molecule (i.e., protein) that recognizes and binds the solid phase support-bio-oligomer, washing nonbound molecules from the mixture, assaying for binding or chemical reaction, detecting binding or the chemical reaction, and isolating a support/bio-oligomer/molecule with the desired property.

As the Office is aware, a reference must teach each and every element as set forth in the claim in order to anticipate. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

However, Lam does not anticipate claims 1-6, 11, 12, 14, 15 and 18-24 for at least the following reasons. Lam does not disclose separating at least one entity-ligand-support complex from the unbound entities, and assaying the activity of the entity of the at least one entity-ligand-support complex separated in step (iii), as is claimed in newly amended claim 1. Lam, at Section 3, column 5, lines 19-24, describes generating a library of bio-oligomers attached to solid phase supports wherein each solid phase support is attached to a single bio-oligomer species. Lam discloses (column 5, lines 32-37) isolating a solid-phase support/bio-oligomer combination that exhibits a desired property from other bio-oligomer solid phase supports, not from “unbound entities” followed by assaying the activity of the entity of the separated entity-ligand-support complex. In addition, Lam fails to show the identical invention in as complete detail as is claimed in currently amended claim 1.

Because Lam fails to teach each and every element of claim 1 and fails to teach the invention in as complete detail as is claimed in claim 1, Lam cannot anticipate claim 1, or, claims 2-6, 11, 12, 14, 15 and 18-24, dependent therefrom.

If the Office maintains this rejection, the Office is respectfully requested to provide a detailed explanation (i.e., cite to specific lines of Lam) of where Lam teaches claim 1 as newly amended.

In view of the deficiencies of Lam, the rejection of claims 1-6, 11, 12, 14, 15 and 18-24 under 35 U.S.C. § 102(b) is legally improper. Reconsideration and withdrawal of the rejection is respectfully requested.

CONCLUSION

In view of the above amendments and remarks, Applicants respectfully request a Notice of Allowance.

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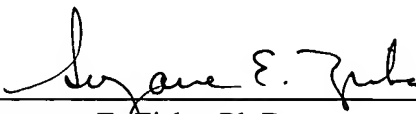
If the Examiner believes a telephone conference would advance the prosecution of this application, the Examiner is invited to telephone the undersigned at the below-listed telephone number.

Respectfully submitted,

MERCHANT & GOULD P.C.

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